REMARKS

The Office Action of April 14, 2004, has been reviewed, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested. Applicants believe that the combination of claim limitations as recited are not disclosed or taught by any of the cited references, alone or in combination. Reconsideration is therefore earnestly requested. No new matter is added with this amendment.

Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-26 are currently rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,463,454 to Lumelsky *et al.* Lumelsky *et al* discusses integrated load distribution and resource management, that includes matching predicted demand for web objects to available capacity on web serves and dynamically shaping both demand and capacity (col. 6, lines 29-36).

For a proper rejection under 102(e), each and every limitation of the claims must be shown in a single reference. Lumelsky *et al* fails to show each and every limitation as claimed by Applicants. Therefore, the rejection is improper and should be withdrawn.

Lumelsky *et al* fails to disclose "a service logic execution engine for enabling service logic to execute on one or more nodes in the network;" "a determination means for determining a preferred distribution scheme wherein the distribution scheme involves placement of nodes ***based on at least one of the group of location of associated physical resources, minimization of inter-node interactions and natural couplings of associated service software***;" and "a distribution means for distributing service functionality to nodes in accordance with the

distribution scheme; ***wherein the service logic execution engine is informed of one or more locations to which one or more application components are distributed.***" Similar limitations are recited in independent claims 10 and 18. These combinations of limitations are simply not shown by Lumelsky *et al.*

Claim Rejections - 35 U.S.C. § 103

Claims 1-26 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable under U.S. Patent No. 6,064,726 to Whited in view of U.S. Patent No. 6,593,355 to Deo *et al.* To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-124 (8th Ed., rev. 1, Feb. 2003).*

Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) ("[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.").

Here, there has been no citation of any teaching anywhere in the art of any need for

determination means for determining a preferred distribution scheme wherein the distribution scheme involves place of nodes based on at least one o the group of location of associated physical resources, minimization of inter-node interactions and natural couplings of associated service software. The Office Action has failed to identify any teaching of that problem specifically. When a primary reference is missing elements, the law of obviousness requires that the Office Action set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention. Because such a proper motivation to combine is missing, the combinations are improper and the rejections should be overturned.

Even if the combination of reference are combined as suggested by the Office Action, the combination would nevertheless fail to disclose the combination of claim limitations. The Office Action admits that Whited does not show "a determination means for determining a preferred distribution scheme wherein the distribution scheme involves placement of nodes." For this deficiency, the Office Action relies upon Deo *et al.* The Office Action alleges that Deo *et al* teaches a determination means for determining a preferred distribution scheme wherein the distribution scheme involves placement of nodes. Based on that alleged teaching, the Office Action concludes that it would have been obvious to modify Whited in view of Deo *et al* "in order to support location and platform-independent services since this would enable high-level logic programs to be run virtually anywhere in the network independent of the service execution

platform." However, Deo *et al* fails to teach at least the determination means as currently amended.

The proposed combination of references fails to disclose, teach or suggest "a service logic execution engine for enabling service logic to execute on one or more nodes in the network;" "a determination means for determining a preferred distribution scheme wherein the distribution scheme involves placement of nodes ***based on at least one of the group of location of associated physical resources, minimization of inter-node interactions and natural couplings of associated service software***;" and "a distribution means for distributing service functionality to nodes in accordance with the distribution scheme; ***wherein the service logic execution engine is informed of one or more locations to which one or more application components are distributed,***" as recited in independent claim 1. In addition, the proposed combination fails to disclose, teach or suggest the steps of "enabling service logic to execute on one or more nodes in the network;" "determining a preferred distribution scheme wherein the distribution scheme involves placement of nodes ***based on at least one of the group of location of associated physical resources, minimization of inter-node interactions and natural couplings of associated service software***;" and "distributing service functionality to nodes in accordance with the distribution scheme," as recited by independent claim 10. Similar limitations are recited in independent claim 18.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-26 be withdrawn. Lumelsky *et al* as well as the combination of Whited and Deo *et al* fail to disclose the claimed combination of limitations. In addition, there is no proper motivation for modifying the references as suggested by the Office Action to include the missing

limitations. As discussed above, there are clear differences between the present invention and Lumelsky *et al.* As further disclosed above, there are clear differences between the present invention and the combination of Whited and Deo *et al.* The references fail to show, teach or make obvious the invention as claimed by Applicants. For at least the reasons presented above, the rejections should be withdrawn.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Date: July 14, 2004

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